

Remarks/Arguments

Entry of the foregoing amendment is respectfully requested. No new matter is added by the amendment to the claims.

Prior to entry of the present amendment, Claims 27-29 and 31-64 were pending in this application. With this amendment, Claims 27-29 and 31-46 have been canceled without prejudice. Applicants expressly reserve the right to pursue any canceled matter in subsequent continuation, divisional or continuation-in-part applications.

The 35 U.S.C. 112, first paragraph, Rejection:

Claims 27-29 and 31-64 were rejected under 35 U.S.C. 112, first paragraph, according to the Examiner because the specification, while being enabling for benzofuran compounds of formula I, does not reasonably provide enablement for "compounds that include a cyclic moiety" or "compounds" as presently claimed. The Examiner further asserts, in part, that the claimed compounds have not been identified by structure, the claimed compounds have not been defined by function, direction and guidance from the specification is lacking, and that "the specification does not contain pharmaceutical compositions containing "compounds that include a cyclic moiety" according to the invention as a component/active ingredient.

Compound Claims 27-29 and 31-46, having been canceled in the present response, Applicants submit that the cancellation of these claims renders the rejection moot. It is emphasized, however, that the cancellation should not be interpreted as acquiescence in the rejection of the canceled claims, or the reasoning underlying such rejection. The rejection, as applied to Claims 47-64 covering the method of identifying an exosite inhibitor of PTP-1B, is respectfully traversed.

Applicants respectfully submit that Claims 47-64 are novel and withdrawal of the rejection is requested.

On page 7 of the Office Action, the Examiner rejected Claims 27-29 and 31-64 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement allegedly because the phrase "compounds that include a cyclic moiety" constitute new matter.

Claims 27-29 and 31-46 having been canceled, the rejection is moot as to these claims. Claims 47-64 do not have the phrase "compounds that include a cyclic moiety" and therefore, the rejection does not apply to Claims 47-64. Withdrawal of the rejection under 35 U.S.C. § 112, first paragraph to Claims 47-64 is respectfully requested.

Double Patenting Rejection:

Claims 27-29 and 31-64 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-24 of U.S. Patent No. 6,784,205 B2. Claims 27-29 and 31-46 having been canceled, the rejection is moot as to these claims. The rejection as to Claims 47-64 over Claims 1-4, 15-16 and 17 of U.S. Patent No. 6,784,205 B2 is respectfully traversed because the respective claims of U.S. Patent No. 6,784,205 B2 recited compounds, exosite mutants and pharmaceutical compositions, while Claims 47-64 of the present application recite various methods of identifying an exosite inhibitors. Similarly, the rejection as to Claims 47-64 over Claims 20-24 of U.S. Patent No. 6,784,205 B2 is respectfully traversed because these claims recite method of treating diabetes, method of treating inflammation, method of treating an immune system disorder and method of treating a hematopoiesis disorders while Claims 47-64 of the present application recite various methods of identifying an exosite inhibitors.

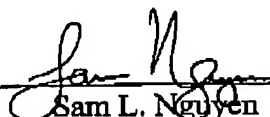
The rejection of Claims 47-64 of the present application over Claims 18 and 19 of U.S. Patent No. 6,784,205 B2 based on an obviousness-type double patenting rejection is believed to be overcome with the filing of a terminal disclaimer, and withdrawal of the

rejection is requested. A Terminal Disclaimer over U.S. Patent No. 6,784,205 B2 is enclosed, and entry is respectfully requested.

Applicants respectfully submit that Claims 47-64, are in condition for allowance, and that allowance is respectfully solicited.

Respectfully submitted,

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